

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SAM JOHNSON, ERIC A. TOOPS, and FRED TANZELLA

Appeal 2007-0199
Application 09/547,710¹
Technology Center 2100

Decided: May 24, 2007

Before: KENNETH W. HAIRSTON, ANITA PELLMAN GROSS, and
JAY P. LUCAS, *Administrative Patent Judges*.

LUCAS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE

Appellants appeal from a final rejection of claims 1-8, 10, 11, 20, 24, 25, 28, 31-34, 42, 44²-58, 80, 89-94, and 96-98 under authority of 35 U.S.C.

¹ Application filed April 11, 2000. Application is a continuation of 09/372,898 and 09/373,260, both filed 8/12/1999. The real party in interest is Avintaquin Capital, LLC.

² It is noted that Examiner omitted claim 44 from the statement of the rejection in paragraph 1, section 9. However, as claim 44 is specifically referenced in paragraph 20, it will be treated as part of this rejection.

§ 134 (2002). The Board of Patent Appeals and Interferences (BPAI) has jurisdiction under 35 U.S.C. § 6(b) (2002).

Appellants' invention relates to a system and method for implementing electronic commerce transactions to a mobile user with presentation content responsive to user input. In the words of the Appellants:

Generally described, the present invention provides for a system, a method, and a device that provide for the ability to receive information content from an information source and deliver the information content to a user or store the information content for later playback. One aspect of the present invention is to provide a closed loop system for delivering the information content obtained from an information content source to a playback device.

(Specification 5).

Claim 1 and Claim 3 are exemplary:

1. A closed loop system for delivering information obtained from an information content source to a playback device, comprising:

a mobile-content server comprising:

an information content source interface;

a playback device interface; and

a server application operating on the mobile-content server and enabling the mobile-content server to be operative to:

receive user information;

obtain content programming information via the information content source interface, the content programming information being based at least in part on the user information and including a plurality of content segments with at least one

of the plurality of content segments including at least one sub-segment;

deliver the content programming information to the playback device via the playback device interface; and

receive response information from the playback device via the playback device interface.

3. The closed loop system of claim 1, wherein the response information is associated with a particular sub-segment of a content segment of the content programming information and the response information solicits various actions based on which sub-segment within the content segment with which it is associated.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Logan	US 5,732,216	Mar. 24, 1998
Hooks	US 6,169,542 B1	Jan. 2, 2001

Group I: Claims 1-8, 10, 11, 20, 28, 31-33, 42, 44, 46-58, 80, 89-94, 96-98 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Logan in view of Hooks.

Group II: Claims 24, 25, 34 and 45 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Logan and Hooks as applied to claims 1, 20, and 42 above, and further in view of well-known technology.

Appellants contend that the claimed subject matter is not rendered obvious by Logan and Hooks alone, or in combination, for reasons to be discussed more fully below. The Examiner contends that each of the groups of claims is properly rejected.

Rather than repeat the arguments of Appellants or the Examiner, we make reference to the Briefs and the Answer for their respective details.

Only those arguments actually made by Appellants have been considered in this decision. Arguments which Appellants could have made but chose not to make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii)(2004).³

We affirm the rejections.

ISSUE

The issue is whether Appellants have shown that the Examiner erred in rejecting the claims under 35 U.S.C. § 103(a). The issue turns on whether there is a legally sufficient justification for combining the disclosures of Logan and Hooks, and on various issues concerning claim interpretation of the word “sub-segments” and the content of the prior art references.

FINDINGS OF FACT

As both claim groups rely on the same primary references and address the same issues, the Findings of Fact will address the claims as a whole.

1. In general terms, Appellants have invented a system for providing customized Internet content to a user with a handheld playback device using a Mobile Content Server to collect the requested information (data or audio) from various web sites, broadcasters or other providers. The playback device connects to the server

³ Appellants have not presented any substantive arguments directed separately to the patentability of the dependent claims or related claims in each group, except as will be noted in this opinion. In the absence of a separate argument with respect to those claims, they stand or fall with the representative independent claim. *See In re Young*, 927 F.2d 588, 590, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991). *See also* 37 C.F.R. § 41.37(c)(1)(vii)(2004).

through a Client Platform, which may be a local personal computer in the user's home or office connected to the handheld device by wireless networking and to the server through the Internet. The content is divided into segments (songs, other audio communications, and advertisements) and possibly sub-segments. See Figure 1 and the Specification for a full explanation.

2. A careful reading of the claims in view of the issues raised in the Brief and Answer indicate a key limitation (in claim 1) to be as follows: "...obtain content programming information via the information content source interface, the content programming information being based at least in part on the user information and including a plurality of content segments with at least one of the plurality of content segments including at least one sub-segment;". In addition, another key limitation from claim 3 is "...wherein the response information is associated with a particular sub-segment of a content segment of the content programming information and the response information solicits various actions based on which sub-segment within the content segment with which it is associated."
3. As an example of the above limitation, Appellants point out in the Specification on page 15, line 22 *ff*, that one sub-segment of an advertisement segment may elicit a user request to be put on a mailing list, another later one may be a request for more information about the product, and a third later still in the segment may be a user request for more information. (Br. 17).

4. Appellants propose that neither Logan nor Hooks teaches the claimed limitation of “response indicators that are associated with sub-segments that solicit certain actions.” (Br. 15).
5. Logan teaches an audio program and message distribution system in which a “hos[t] organizes the program segments by subject matter and creates scheduled programming in accordance with preferences associated with each subscriber.” (Logan, Abstract). The content may be audio or text converted to audio, and may be news sources, announcements, advertisements (col. 5, l. 6 *ff*) from various sources including the Internet (col. 8, l. 50*ff*). The selection of content is based on information supplied by the user and sent to a server (col. 7, l. 17*ff*) which then customizes the segments to be sent to the user. Segments in Logan contain content information and various data fields, including whether the segment is an episode of a larger program, and is addressed to users of certain ages, sexes, special interest groups and other factors listed in the segment table shown in column 16. User reaction to segments, called “comments,” may be responses to advertisements including requests for more information or a purchase transaction (col. 42, l. 59). As a segment plays in Logan, a byte location is recorded to indicate where in the segment the user is listening. These byte locations allow jumping to various spots in a segment (col. 38, l. 24*ff*). It also allows comments, which may be responses to ads, to be keyed to exact locations within the playing program file (col. 41, middle).

6. Hooks teaches an interactive video distribution system for a plurality of subscriber units to be able to receive customized video programming. (Hooks Abstract and Fig. 1). Various video sources feed a server, from which program segments are sent to interactive video subscribers. (Fig. 1). Segments include program specific data (col. 5) concerning the information content provided. The video may be full-motion video, movies, TV, textual questions, answers and advertisements. The various segments of programming may have advertisement segments, and as seen in Figure 9 may solicit and receive requests from the users for more information or placements of orders for the product advertised in response to the exact advertisement presented.
7. Appellants contend that the motivation to combine the references of Logan and Hooks is missing from the rejection. The proper foundation for a combination of references is whether the references derive from the same field of endeavor, or address the same problem. (See Principles of Law below). As itemized above, the demonstrated portions of the disclosures indicate that the respective inventors were addressing the same technological problem (responding to user feedback in a content distribution system) and were in the same field of endeavor (distribution of content with user feedback). We find, therefore, that the combination of these references is well founded.
8. Appellants contend that the Hooks reference teaches away from the claimed subject matter. A careful review of Hooks indicates

that it does not “criticize, discredit, or otherwise discourage the solution claimed.” It merely shows an alternative solution that renders aspects of the claimed subject matter obvious, when rejected in combination with Logan. See the guidance of the Federal Circuit from *In re Fulton* cited below.

9. The major contention of the Appellants concerns limitations that are alleged to not be disclosed in the Logan or Hooks references. More specifically, Appellants indicate “[w]hile Logan does teach the delivery of content in the form of segments, there is no description of further dividing the content segments into sub-segments.” (Br. 14). We note, first of all, that while the segments are claimed as “content segments,” the claim does not require sub-segments to contain program contents. In Logan, column 16, is a table of the various data elements in a segment including information on the age of listeners, sex, program preferences, type of programming in the segment, etc. associated with a program segment. These data elements are readable upon Appellants’ sub-segments. The claimed sub-segments themselves, as well as the response information associated with a sub-segment of claim 3, would be readable on Logan’s teaching of response to these attributes of a segment.
10. However, the patent to Logan contains teachings much closer to the argument as framed by the Appellants. As mentioned in Finding #5 above, the Logan disclosure permits user responses in the form of comments to be keyed to particular sub-sections

within a single segment, by the use of byte locations disclosed in column 41 *ff*. These comments may include user actions, such as a request for additional services or transactions. (Logan, col. 42, line 60). We thus find within Logan the closed loop system where the playback device can be used to receive content programming segments, and the system can receive response information keyed to sub-sections of a segment from the user.

11. The teachings of Hooks are similar to those of Logan in the respect of showing user feedback in a closed loop video distribution system, where the user interacts with the programming supplied to his equipment. Of special interest in Hooks is the variety of responses indicated in Figure 9, keyed to an advertising sub-section of a segment. Potential user responses listed include a request for more information, or the placement of an order, etc.

PRINCIPLES OF LAW

On appeal, Appellant bears the burden of showing that the Examiner has not established a legally sufficient basis for the rejection of the claims.

“In reviewing the [E]xaminer’s decision on appeal, the Board must necessarily weigh all of the evidence and argument.” *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

In sustaining a multiple reference rejection under 35 U.S.C. § 103(a), the Board may rely on one reference alone without designating it as a new ground of rejection. *In re Bush*, 296 F.2d 491, 496, 131 USPQ 263, 266-67

(CCPA 1961); *In re Boyer*, 363 F.2d 455, 458 n.2, 150 USPQ 441, 444 n.2 (CCPA 1966).

In *Fulton*, Appellants have raised the issue of Goluszek teaching away from the claimed invention. Our guiding court has held “[t]he prior art’s mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed in the ‘198 application.” (*In re Fulton*, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146, (Fed. Cir. 2004).

Our reviewing court states in *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) that “claims must be interpreted as broadly as their terms reasonably allow.” Our reviewing court further states, “[t]he terms used in the claims bear a ‘heavy presumption’ that they mean what they say and have the ordinary meaning that would be attributed to those words by persons skilled in the relevant art.” *Texas Digital Sys. Inc v. Telegenix Inc.*, 308 F.3d 1193, 1202, 64 USPQ2d 1812, 1817 (Fed. Cir. 2002).

References within the statutory terms of 35 U.S.C. § 102 qualify as prior art for an obviousness determination only when analogous to the claimed invention. *In re Clay*, 966 F.2d 656, 658, 23 USPQ2d 1058, 1060, (Fed. Cir. 1992). Two separate tests define the scope of analogous prior art: (1) whether the art is from the same field of endeavor, regardless of the problem addressed and, (2) if the reference is not within the field of the inventor's endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved. *In re Deminski*, 796 F.2d 436, 442, 230 USPQ 313, 315 (Fed. Cir. 1986); *see also In re Wood*,

599 F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA 1979) and *In re Bigio*, 381 F.3d 1320, 1325, 72 USPQ2d 1209, 1212 (Fed. Cir. 2004).

ANALYSIS

Appellants contend that the Examiner erred in rejecting claims 1-8, 10, 11, 20, 24, 25, 28, 31-34, 42, 44-58, 80, 89-94, and 96-98. Reviewing the Findings of Facts cited above, the elements of the claims may be read as being obvious over the disclosures of Logan and Hooks. Logan's disclosure of a closed loop audio distribution system taught the segmented content as claimed, with user response information being keyed to sub-sections within the segment. These sub-sections could either be of a data-type nature, or actually be part of the information content (audio) provided to the user. User action is received by the system, for example, as responses to the advertising information in the sub-sections including transactions that may be performed or requests for more information. Hooks, in a closed loop video distribution system, adds the teachings of clearly defined user requests for more information or to purchase advertised products keyed to the advertising sub-section of the information segment.

CONCLUSION OF LAW

Based on the findings of facts and analysis above, we conclude that the Examiner did not err in rejecting claims 1-8, 10, 11, 20, 24, 25, 28, 31-34, 42, 44-58, 80, 89-94, and 96-98. The rejections of those claims are affirmed.

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DECISION

The Examiner's rejection of claims 1-8, 10, 11, 20, 24, 25, 28, 31-34, 42, 44-58, 80, 89-94, and 96-98 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv)(2006).

AFFIRMED

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